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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,234	11/14/2005	Itzhak Gvishi	4110-39	9064

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EXAMINER

MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/532,234

Applicant(s)

GVISHI, ITZHAK

Examiner

Vishu K. Mendiratta

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 10 provides for the use of apparatus structure, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what is being claimed. "either a physical form or a virtual form" is indefinite.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim is an abstract idea of "use of a board". No actual use/method steps to practice in the claim.

Also the claimed invention lacks patentable utility. It is claiming a "computer program".

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-18,20-26 rejected under 35 U.S.C. 102(b) as being anticipated by Navin (5513849).

Navin teaches a cross-shaped board having a center of at least 6x6 cells, four arms each comprising at least 3x6 cells, at least 108 cells total, four sets of pieces each set having a first subset of at least six pieces (king, queen, bishop, rook, 2 rooks) and a second subset of at least six pieces (pawns), game pieces being in light and dark colors (3:20-26). Navin teaches game pieces in different shapes that can be used to define the motion of game pieces. Further game pieces are inherently made from wood, plastic or cardboard material and also well known in game industry.

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Applicant may note that applicant's claims are open ended and references used to reject claims can have more limitations than presented in applicant's claims. **For example:** 6x6 can be 8x8 and 3x6 can be 3x8.

Applicant may also note that rules/method steps/intended use for playing a do not further limit the apparatus in the claim. **For example:** claim 1a) through 1c), 4 through 9, 11-18, several limitations do not further limit the apparatus in the claim and only indicate how to use the apparatus.

Claims 25-26 are product by process claims and Navin clearly teaches the final product being the same as broadly claimed.

7. Claims 25-26 rejected under 35 U.S.C. 102(b) as being anticipated by Eigen (4043559).

Eigen teaches a method of generating a game board with a base board (4) covered by a frame (5), leaving the uncovered area (9) to define a game board (Fig.5).

8. Claims 1-26 rejected under 35 U.S.C. 102(a) as being anticipated by Taurus Games.

Taurus games teaches a chess game having 108 cells, 6x6 center, 4 sides having 3x6 cells, four sets of colored game pieces, each set having a first subset of 6 pieces, 2 alike and three different pieces, and a second set of 6 alike pieces.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-18,20-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (D85960) in view of Navin.

Smith teaches a chess game having 108 cells, 6x6 center, 4 sides having 3x6 cells.

Smith does not teach game pieces.

Navin teaches (3:17-26) four sets of colored game pieces, each set having a first subset of 6 pieces, 2 alike and three different pieces, and a second set of 6 alike pieces.

Navin and Smith are both 4 player, 4-way chess boards. It is well known in the chess art to play with four sets of game pieces. In order to play a 4 player chess game it would have been obvious to provide four sets of game pieces. One of ordinary skill in art at the time the game was invented would have suggested providing game pieces for four players to play the game.

11. Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (D85960) in view of Navin and further in view of Aldridge (5957455).

Smith teaches a chess game having 108 cells, 6x6 center, 4 sides having 3x6 cells.

Smith does not teach game pieces.

Navin teaches (3:17-26) four sets of colored game pieces, each set having a first subset of 6 pieces, 2 alike and three different pieces, and a second set of 6 alike pieces.

Navin and Smith are both 4 player, 4-way chess boards. It is well known in the chess art to play with four sets of game pieces. In order to play a 4 player chess game it would have been obvious to provide four sets of game pieces. One of ordinary skill in art at the

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time the game was invented would have suggested providing game pieces for four players to play the game.

Smith and Navin teach all limitations except that they do not expressly indicate making game pieces for plastic or cardboard.

Aldridge teaches making game pieces with several different well known materials including card board and plastic.

Materials are selected to suit the design of game for being light weight or for being cost effective. Plastic and card board are cost effective materials and often used in game industry. In order to make the game cost effective it would have been obvious to use cardboard or plastic to make game pieces.

12. Claim 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Navin in view of Houman (5908193).

Navin teaches all limitations except that it does not teach cells in other than square shapes.

Houman teaches other shapes of cell configuration.

Game boards are used for amusements and in order to make the game attractive to potential players it would have been obvious to have decorative shapes. One of ordinary skill in art at the time the invention was made would have suggested making decorative cell shapes.

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 3608904 shows move capabilities printed on game pieces, 1674533 teaches blocking off outer areas of a game board to modify a game.

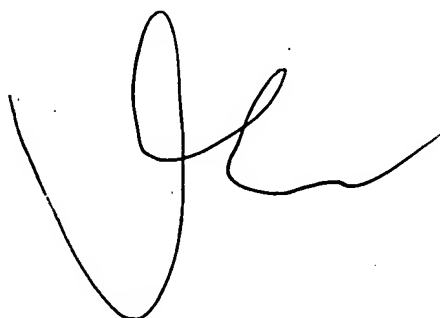
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K. Mendiratta whose telephone number is (571) 272-4426. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vishu K Mendiratta
Primary Examiner
Art Unit 3711

VKM
April 5, 2007

A handwritten signature in black ink, appearing to be 'VKM', with a large loop and a trailing flourish.